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EXAMINER

KHOSRAVAN, JIMAN

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 11/10/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,412

Applicant(s)

TULI, RAJA SINGH

Examiner

Jiman Khosravan

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1, 2, 1/3, 2/3, 1/4, 2/4, 1/5, 2/5, 1/6, 2/6, 1/7, 2/7, 1/8, 2/8, 1/9, 2/9, 1/10, 2/10, 1/11, 2/11, 1/12, 2/12, 1/13, 2/13, 1/14, 2/14, 1/15, 2/16, 1/17, 2/17, 1/18, 2/18, 1/19, and 2/19 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1, 2, 1/3, 2/3, 1/4, 2/4, 1/5, 2/5, 1/6, 2/6, 1/7, 2/7, 1/8, 2/8, 1/9, 2/9, 1/10, 2/10, 1/11, 2/11, 1/12, 2/12, 1/13, 2/13, 1/14, 2/14, 1/15, 2/16, 1/17, 2/17, 1/18, 2/18, 1/19, and 2/19 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/29/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

U.S. Patent and Trademark Office
PTOL-326 (Rev. 04-01)

Office Action Summary

Part of Paper No. 3

DETAILED ACTION

Drawing Objections

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Item 6: virtual browser, in figures 9 and 12, page 14: lines 6 and 24, respectively.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Item 13, figure 3; Item 1, figure 4; item 18, figure 9; item 33, figure 11; and items 18 and 26, figure 12.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Appropriate correction is required.

Specification Objections

3. The abstract of the disclosure is objected to because of the length of the abstract.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Correction is required. See MPEP § 608.01(b).

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..."

(Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1 and 2 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of copending Application No. 09/764,418. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections ~ 35 U.S.C. § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. As per claim 1, the claim recites the limitations "the outside" in line 1, "the rasterized image" in line 2, and "that image" in line 3. There is insufficient antecedent basis for these limitations in the claim.

b. As per claim 2, the claim recites the limitations "the outside" in line 1, and "that image" in line 3. There is insufficient antecedent basis for these limitations in the claim.

c. As per claim 3, the claim recites the limitations "the image" in line 1 and line 2. There is insufficient antecedent basis for these limitations in the claim.

d. As per claim 4, the claim recites the limitations "the outside" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections ~ 35 U.S.C. § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 1/12, 2/12, 1/16, 2/16, 1/17, and 2/17 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamakado et al. (US 6,014,133).

a. As per claims 1 and 2, Yamakado discloses a data transmitter/receiver where a host computer system receives information from the outside, rasterizes it, compresses the rasterized image and transmits it to a device, which decompresses that image and displays it on a screen. (Abstract; Col. 4, lines 50-67; Col. 5, lines 6-27 & 46-56; Col. 6, lines 60-67; Col. 9, lines 66-67; Col. 10, lines 1-10; Col. 17, lines 38-44; Fig. 5. & 18: Yamakado teaches that both devices have data transmitter/receiver capabilities).

b. As per claims 1/12 and 2/12, Yamakado discloses a device such that all text and graphics received by the host computer is rendered entirely by a browser into a single image in its memory onto a virtual display, of a reduced color depth whereby this reduced image is further subdivided impartially into smaller segments, which are compressed and sent to a remote device which is capable of

receiving, storing into memory, decompressing and displaying an assembled image to the user (Col. 6, lines 35-44 & lines 60-67; Col. 9, lines 66-67; Col. 10, lines 1-10; Col. 11, lines 27-60; Fig. 5 & 18).

c. As per claims 1/16 and 2/16, Yamakado further teaches a device that contains internal memory with related microelectronics to store and view rasterized web pages or other images (Col. 9, lines 66-67; Col. 10, lines 1-10).

d. As per claims 1/17 and 2/17, Yamakado further teaches a device that contains internal memory with related micro-electronics to generate, store and view text files to be transmitted to a virtual browser in the host computer at any time, when connected to a cellular phone or other transmitting means (Col. 1, lines 9-14; Col. 4, lines 51-56; Col. 9, lines 66-67; Col. 10, lines 1-10; Col. 17, lines 39-45).

Claim Rejections ~ 35 U.S.C. § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1/3 and 2/3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakado, and further in view of Dorricott (US 6,125,209).

Yamakado discloses the claimed invention as described above and further teaches scrolling of the rasterized image may be performed at the device. However Yamakado does not explicitly teach the information sent to the device remains compressed, and parts of the image viewed as a user scrolls through the image are decompressed prior to viewing. Dorricott teaches a device, which decompresses data images to be displayed on a screen, in scrollable format, and further teaches when all the data cannot fit onto the display; the device would decompress the remaining data during a smooth or rapid scroll (Abstract; Col. 1, lines 64-67; Col. 2, lines 1-9; Col. 7, lines 4-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Dorricott in the system of Yamakado, because by decompressing only portions of the image which is currently displayed and not the entire image allows for faster transfer of data from device to display, and further decreasing waiting time for the user (Abstract; Col. 1, lines 41-48; Col. 2, lines 16-20).

12. Claims 1/4, 2/4, 1/13, and 2/13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakado, and further in view of Tso et al. (US 6,185,625).

a. As per claims 1/4 and 2/4, Yamakado discloses the claimed invention as described above. However Yamakado does not explicitly teach the host computer gets its information from the Internet. Tso teaches a network server that manages the transfer of data from the Internet to a network client (Col. 5, lines 50-55; Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tso in the system of Yamakado, because the Internet is quickly becoming data communications medium for a broad class of computer users (Col. 1, lines 12-13).

b. As per claims 1/13 and 2/13, Yamakado-Tso further discloses a device such that all text and graphics received by the host computer, is converted to monochrome or color raster images of various depths of color, at a virtual browser in the host computer prior to compression and sending to the device (Yamakado: Col. 5, lines 6-27 & lines 46-56).

13. Claims 1/18, 2/18, 1/19, and 2/19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakado, and further in view of Cronin, III et al. (US 6,182,127).

a. As per claims 1/19 and 2/19, Yamakado discloses the claimed invention as described above. However Yamakado does not explicitly teach the screen of the device contains icons which represent specific commands, linked to icons or menu items on a virtual browser in the host computer, such that the virtual browser may contain icons in different locations than icons on the device, whereby the virtual browser has a mapped location of all icons on the device, such that a message is sent to the host computer for any command executed by the device, informing of the specific icon location selected which is translated into appropriate commands. Cronin III teaches image files sent to a client workstation using graphical web browsers to display the view of an image from the server. Cronin III further discloses the user is allowed to click on any point in the image and the device sends a message to a host (a hyperlink, menu, or icon), wherein the host sends back a refreshed raster image (Col. 3, lines 18-61; Col. 8, lines 23-67; Col. 9, 1-48: Cronin III sends the page (scaled and regional) related to the hyperlink to the client).

b. As per claims 1/18 and 2/18, Yamakado-Cronin III discloses the claimed invention as described above and further teach a device that contains icons which represent specific commands, linked to icons or menu items on a virtual browser in the host computer, such that the virtual browser may contain icons in different

locations than icons on the device, whereby the device contains in a memory a mapped location address of all icons and menu commands on the virtual browser, such that any icon selected on the device is linked to the appropriate command or sequence of commands on the virtual browser, which are immediately executed (Yamakado: Col. 17, lines 39-45).

14. Claims 1/6 and 2/6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakado-Cronin III, and further in view of Gardell (US 6,049,831).

Yamakado-Cronin III discloses the claimed invention as described above. However, Yamakado-Cronin III does not explicitly teach text character selected on the device is sent and entered in a virtual browser in the host computer in a location selected for text input, whereby the host computer sends a refreshed portion of the virtual browser back to the device as an image, to be displayed. Gardell discloses a method to present a user with a menu of where Uniform Resource Locators or other Web-related selections, can be entered using the user interface (Gardell: Col. 3, lines 15-67; Col. 4, lines 1-54; Col. 5, lines 10-16 & lines 41-46; Col. 7, lines 14-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of text

entry of Gardell in the system of Yamakado-Cronin III, in order to show regular functions (undisclosed in Cronin III) of a web browser.

15. Claims 1/5, 2/5, 1/8, 2/8, 1/9, 2/9, 1/10, 2/10, 1/11, and 2/11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakado-Cronin III-Gardell, and further in view of Clough (US 5,379,057).

a. As per claims 1/8 and 2/8, Yamakado-Cronin III discloses the claimed invention as described above. However, Yamakado-Cronin III does not explicitly teach if a user clicks on a location on the display, a message is sent to the host computer which determines if text input is required at that specific location and further, if text is required, an electronic touch screen keyboard is invoked and appears in the screen of the device. Gardell discloses if the user requests a page with a text input field, the host sends the user the translated page with the text input field to be filled in (Gardell: Col. 3, lines 25-67; Col. 4, lines 1-54; Col. 5, lines 10-16 & lines 41-46; Col. 7, lines 14-25).

However, Yamakado-Cronin III-Gardell does not explicitly teach the electronic touch screen keyboard to be invoked at this time. Clough discloses a portable computer with touch screen (Abstract; Col. 2, lines 53-63). Clough further teaches a simulated keyboard to appear on the display at appropriate times as data

entry devices (Col. 3; lines 7-13). Clough also teaches the keyboard to be produced when input from a keyboard is required (Col. 20, lines 8-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Clough in the system of Yamakado-Cronin III-Gardell, in order to show regular functions (undisclosed in Cronin III) and further because typical hand-held devices have limited display screen sizes (Clough: Col. 1, lines 34-35).

b. As per claims 1/5 and 2/5, Yamakado-Cronin III-Gardell-Clough further teaches the text to appear in a text area (Clough: Fig. 12a, 12c, 12d).

c. As per claims 1/9 and 2/9, Yamakado-Cronin III-Gardell-Clough further teaches the electronic touch screen keyboard on the screen of the device to automatically disappear once text has been entered and sent to the host (Clough: Col. 20, lines 8-14; the keyboard disappears until needed again).

e. As per claims 1/10, 2/10, 1/11, and 2/11, Yamakado-Cronin III-Gardell-Clough further teaches an external keyboard attached to the device (Clough: Col. 2, lines 53-64).

16. Claims 1/7 and 2/7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakado-Cronin III-Gardell-Clough, and further in view of Ouellette et al. (US 5,581,243).

Yamakado-Cronin III-Gardell-Clough discloses the claimed invention as described above, however, Yamakado-Cronin III-Gardell-Clough does not explicitly teach that each text character selected on an electronic touch screen keyboard on the screen of the device, the matrix locations of the touch screen are sent from the device to the host computer. Ouellette discloses a phantom keyboard that is formed on a touch sensitive display as an input tool for a computer. Ouellette further teaches the matrix location of the touched screen is sent to the computer for processing (Abstract; Col. 5, lines 4-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ouellette, in the system of Yamakado-Cronin III-Gardell-Clough, because it is known in the art that simulated keyboards of this type, each key of the simulated keyboard is represented by a discretely defined area bounded by a frame *Col. 1, lines 44-50).

17. Claims 1/14, 2/14, 1/15, and 2/15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakado, and further in view of MacLeod et al. (US 5,778,092).

a. As per claims 1/14 and 2/14, Yamakado discloses the claimed invention as described above, however, Yamakado does not explicitly teach that the priority of decompression is determined by the depth of color of the image, with the minimum depth being decompressed first. MacLeod teaches a method for compressing color or gray scale pixel map representing a document where a three-plane representation of the image takes place: a reduced-resolution foreground plane (text), a reduced-resolution background plane (color/gray scale of background), and high-resolution binary selector plane (binary information for selecting a plane), and they are all compressed using a compression technique. MacLeod further teaches them to be decompressed in order of minimum color depths (Col. 14, lines 42-64: text, then background, then binary information). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of MacLeod, in the system of Yamakado, because by being able to decompress based on minimum color depth, you are able to implement very high levels of compression (Col. 1, lines 10-43).

b. As per claims 1/15 and 2/15, Yamakado discloses the claimed invention as described above, however, Yamakado does not explicitly teach that text or monochrome portions of the image are decompressed first and displayed on the screen, with color portions decompressed and overlain in parts of the image shortly after. MacLeod teaches a method for compressing color or gray scale pixel map representing a document where a three-plane representation of the image takes place: a reduced-resolution foreground plane (text), a reduced-resolution background plane (color/gray scale of background), and high-resolution binary selector plane (binary information for selecting a plane), and they are all compressed using a compression technique. MacLeod further teaches them to be decompressed in order of minimum color depths (Col. 14, lines 42-64: text, then background, then binary information). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of MacLeod, in the system of Yamakado, because by being able to compress and decompress text and background individually, you are able to implement very high levels of compression (Col. 1, lines 10-43).

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jiman Khosravan whose telephone number is (703) 305-0704. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rupal.dharia@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Art Unit: 2141


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jiman Khosravan

Examiner

Art Unit 2141

October 15, 2003


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER